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| 09/887,491 | 06/22/2001 | Mototsugu Abe | 09792909-5051 | 7720 |

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EXAMINER

LAYE, JADE O

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2614

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,491

Applicant(s)

ABE ET AL.

Examiner

Jade O. Laye

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a. There are no Figures labeled 16, 18, 20, 21, or 22 as stated on page 10 of the Specification.
 - b. There is no description of Figures 16A-D within the Specification.
 - c. There is no description of Figures 18A-C within the Specification.
 - d. There is no description of Figures 20A-F within the Specification.
 - e. There is no description of Figures 21A-F within the Specification.
 - f. There is no description of Figures 22A-F within the Specification.Appropriate correction is required.

Title

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested Applicant include language related to “automatic detection of embedded data pertinent to commercial messages.”

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, 8, 9, 16, 18, 19, 20, 22-24, 27, 28, 32-35, 37, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolzien. (US Pat. No. 5,761,606).

As to claim 1, Wolzien discloses a system which provides direct automated access to online information via a URL embedded within the audiovisual signal. More specifically, Wolzien discloses a transmission means (i.e., public/private network connected via transmission line), detailed information furnishing means (i.e., online info providers), access site information furnishing means (i.e., network), means for detecting pre-set signal (i.e., embedded signal), and a means for connecting to and acquiring the access site information. (Abstract ; Col. 1, Ln. 5-11 ; Col. 2, LN. 59-67 thru Col. 3, Ln. 1-15 & 24-49 ; Col. 7, Ln. 22-67 thru Col. 8, Ln. 1-5 ; Figure 1). Accordingly, Wolzien anticipates each and every limitation of claim 1.

Claims 5, 16, 20, 24, 32, and 35 correspond to claim 1. Thus, each is analyzed and rejected as previously discussed.

As to claim 3, Wolzien further teaches the pre-set signal can be embedded within a commercial message. (Abstract & Col. 1, Ln. 45-50). Accordingly, Wolzien anticipates each and every limitation of claim 3.

Claims 8, 18, 22, 27, 33, and 37 correspond to the system claim 3. Thus, each is analyzed and rejected as previously discussed.

As to claim 4, Wolzien further teaches the access site information can be a URL. (Abstract & Col. 1, Ln. 5-11). Although not explicitly discussed, Wolzien teaches the provision

of online information via an address (i.e., URL address). Thus, it is inherently disclosed. Accordingly, Wolzien anticipates each and every limitation of claim 4.

Claims 9, 19, 23, 28, 34, and 38 correspond to the system claim 4. Thus, it is analyzed and rejected as previously discussed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 6, 7, 10-15, 17, 21, 25, 26, 29-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolzien in view of Matthews, III et al. (US Pat. No. 6,025,837).

Claim 2 recites the information transmission/reception system of claim 1, wherein:

said detection section detects transmission time as said pre-set signal in said transmission signal and a frequency or a transmission channel of said transmission signal;
said first connecting section connects to said access site information furnishing means; and

wherein said first acquisition section acquires the access site information associated with the transmission time as said pre-set signal and the frequency of the transmission channel of said transmission signal, which are detected by said detecting section.

As discussed above, Wolzien discloses all limitations of claim 1, but fails to specifically recite the limitations of claim 2. However, within the same field of endeavor, Matthews discloses a similar system in which an Electronic Programming Guide detects the signal transmission time and channel via a connection to an enhanced content and media server. (Abstract ; Col. 4, Ln. 27-65 ; Col. 7, Ln. 9-41 ; Col. 9, Ln. 56-67 thru Col. 10, Ln. 1-13 ; Figures 1-3 & 5). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Wolzien and Matthews in order to provide a system wherein the user could readily identify supplemental information related to audiovisual

signals and access that same information automatically, without the need to move to a separate computer terminal.

Claims 6, 21, and 25 correspond to claim 2. Thus, each is analyzed and rejected accordingly.

Claim 7 recites the system of claim 5, further comprising: storage means for storing said pre-set signal detected by said detecting section; browsing means for browsing a plurality of said pre-set signals stored in said storage means as necessary; and retrieving means for retrieving a desired signal from said plurality of the pre-set signals stored in said storage means. As discussed above, Wolzien discloses all limitations of claim 5, and further teaches the use of a storage means for storing the URL addresses. (Col. 3, Ln. 50-57 ; Col. 5, Ln. 42-67 thru Col. 6, Ln. 1-7). But, Wolzien fails to disclose the remaining limitations of claim 7. However, within the same field of endeavor, Matthews discloses an EPG (i.e., browsing means) which contains a plurality of embedded URLs. (Col. 4, Ln. 37-65 ; Col. 6, Ln. 59-67 thru Col. 7, Ln. 1-42 ; Col. 9, Ln. 56-67 thru Col. 10, Ln. 1-13). Accordingly, the combined systems of Wolzien and Matthews contain all limitations of claim 7.

Claims 17, 26, and 36 correspond to the system claim 7. Thus, each is analyzed and rejected as previously discussed.

Claim 10 recites an information processing apparatus comprising limitations too numerous to recite herein. (please refer to claim sheet). The limitations of claim 10 are only combinations of limitations from claim 1, 2, and 7. Accordingly, in so far as they correspond, each is analyzed and rejected as previously discussed therein.

The limitations of claims 11 and 12 correspond to those recited in claims 3 and 4, respectively. Accordingly, each is analyzed and rejected accordingly.

The limitations of claim 13 are combinations of limitations from claims 1 and 2. Thus, it is analyzed and rejected as previously discussed.

Claims 14 and 15 correspond to claims 3 and 4, respectively. Thus, each is analyzed and rejected as previously discussed.

Claim 29 recites limitations which are combinations of claims 1 and 2. Thus, it is analyzed and rejected as previously discussed.

Claims 30 and 31 corresponds to claims 3 and 4, respectively. Thus, each is analyzed and rejected as previously discussed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Harper et al (US Pat. No. 5,585,858) disclose a simulcast on interactive signals within a video signals.
- b. Throckmorton et al (US Pat. No. 5,818,441) disclose a system which transmits embedded signals within a video stream.
- c. Kikinis (US Pat. No. 5,929,849) discloses a system which integrates URLs within video signals.
- d. Portuesi (US Pat. No. 5,987,509) discloses a system for displaying URLs embedded within video signals.
- e. Ullman et al (US Pat. No. 6,018,768) disclose a system for transmitting enhanced video programming.

- f. Bendinelli et al (US Pat. No. 6,061,719) disclose a system for synchronized presentation of television programming and web content.
- g. Ullman et al (US Pat. No. 6,330,595) disclose a system for transmitting enhanced video programming.
- h. Blacketter et al (US Pat. No. 6,560,777) disclose a broadcast enhancement trigger.
- I Nobakht et al (US Pat. No. 6,745,223) disclose a user terminal for channel based internet networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials
May 24, 2005.



NGOC-YEN VU
PRIMARY EXAMINER